

REMARKS

This application has been carefully reviewed in light of the Office Action mailed June 25, 1997. To advance prosecution of this case, the Examiner's rejection of the claims is respectfully traversed. Applicants respectfully request reconsideration and favorable action.

The Examiner rejects Claims 1-20 under the Recapture Doctrine as set forth in M.P.E.P. § 1412.02.

As stated in M.P.E.P. § 1412.02, the recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than claims canceled from the original application. Interpreting the recapture rule, the Federal Circuit stated in *Mentor Corp. v. Coloplast Inc.*, 27 USPQ2d 1521 (Fed. Cir. 1993), upon which the Examiner relies, that the recapture rule "does not apply where there is no evidence that amendment of the originally filed claims was in any sense an admission that the scope of that claim was not in fact patentable." *Id.* at 1524. As the Federal Circuit made clear, although error under the reissue statute "does not include a deliberate decision to surrender specific subject matter in order to overcome prior art," if a reissue claim is broader "in a way that does not attempt to reclaim what was surrendered earlier," the recapture rule does not apply. *Id.* at 1525. Furthermore, in *Patecell v. U.S.*, 12 USPQ2d 1440 (Cl. Ct. 1989), another case upon which the Examiner relies, the court stated that "[a]s the CAFC recognized in *Ball Corp.*, the crucial issue in assessing the significance of the cancellation (or narrowing) of a claim on the existence of 'error' is the intent of the applicant when he or she canceled the claim." *Id.* at 1447.

Applying the law cited above to the present reissue application, it is abundantly clear that Applicants made no deliberate decision in prosecuting the original application to surrender the liquid filter subject matter to overcome prior art, as required for the recapture rule to apply. Furthermore, the reissue claims in this application are broader than the original patent claims in a way that does not attempt to reclaim subject matter, if any, that might possibly have been surrendered in prosecuting the original application. Even if the Examiner's assertion is true that "addition of narrowing limitations to a claim to overcome prior art is considered the full equivalent" of canceling the claim and substituting a claim of narrower scope "to overcome the prior art," the file history of the original patent shows the recapture rule to be inapplicable to the

claims of the present reissue application. Consequently, Applicants respectfully traverse the Examiner's rejection below.

In seeking the original patent, Applicants repeatedly and consistently argued that the recited combustion chambers and the order of their operation were important aspects of the invention and entirely sufficient to define over the prior art. The mere fact that Applicants also pointed out that the prior art failed to teach or suggest the recited filter element, with its ability to reduce the quantity of CO, NO, SO, HCL, or SO₂, does not in any way amount to an admission that the recited filter element was necessary to overcome the prior art. For example, on Page 5 of Paper No. 5, filed August 19, 1991, Applicants state:

Applicants have shown that each of the references relied on omit critical features of Applicants' invention. Moreover, no reference teaches or suggests the use of first and second combustion chambers where the first combustion chamber incinerates waste material "in an oxygen rich atmosphere" and the second combustion chamber incinerates the fired exhaust in an "oxygen starved atmosphere." *In addition*, no reference teaches or suggests a liquid filter that both captures particulate matter and treats the exhaust "to reduce the quantity of CO, NO and SO."

(emphasis added)

The Examiner asserts that Applicants amended Claim 1 in Paper No. 12, filed November 16, 1991, "to distinguish over Hadley by adding 'said' to modify 'particulate matter' and by adding 'fired' to change said 'exhaust gasses' to 'said fired exhaust gasses.'" Applicants respectfully dispute this assertion. In Paper 12, the first combustion chamber element was amended to recite "exhaust containing gasses and particulate matter." The second combustion chamber element was amended accordingly to recite "firing said exhaust containing gasses and particulate matter" The liquid filter element was amended accordingly to recite "capturing said particulate matter contained in said fired exhaust and for chemically treating said fired exhaust gasses" Nowhere have Applicants shown a deliberate attempt to do anything but place the claim as a whole in compliance with 35 U.S.C. § 112 given the narrowing amendment to the first combustion chamber element, which is the only element that can be said to have been narrowed in view of Hadley. Applicants did not narrow the liquid filter element of the claim even with the addition of "fired" and "gasses," since the fact that the exhaust contained gasses and was fired was already explicitly recited in the second combustion chamber element. There

is absolutely no basis whatsoever in the file history or otherwise to support the notion that Applicants deliberately narrowed the liquid filter element to overcome Hadley or any other prior art, as required even under the Examiner's statement of the recapture rule quoted above.

In the remarks on Pages 3-4 of Paper No. 12, in addition to again arguing that the art relied on by the Examiner did not teach or suggest the recited first and second combustion chambers, Applicants argued that, in addition, the prior art did not teach or suggest the recited liquid filter. As Applicants stated on Page 4 of Paper No. 12:

Applicant *further submits* that the liquid filter of Claim 1 and the liquid filter means of Claim 22 require "capturing said particulate matter contained in said fired exhaust and for chemically treating said fired exhaust gasses to reduce the quantity of CO, NO and SO contained in said fired exhaust."

(emphasis added)

Applicants also state on Page 4 of Paper No. 12: "A claim should not be rejected if there is a single limitation not taught or made obvious by the prior art. Here, there are two limitations in each of the rejected claims that is [sic] nowhere disclosed or even suggested by the prior art." Applicants did nothing more in the original application than argue that the claims were patentably distinct from the prior art in at least two independent respects and that allowance was therefore appropriate.

Regarding Claim 22 (which later became Claim 15 of the original patent), the Examiner asserts that Applicants amended Claim 22 in Paper 12 "to insert 'filter' to change 'liquid means' to 'liquid filter means' and added 'said' to modify 'particulate matter' in the last clause of that claim." The amendments to Claim 22 are for the most part, like the amendments to Claim 1, purely to place the liquid filter means element in compliance with 35 U.S.C. § 112 given the narrowing amendment to the first combustion chamber element. Even if the amendment of Claim 22 to recite "liquid filter means" rather than "liquid means" could be said to be narrow Claim 22, the requirements of the recapture rule are still not satisfied. Applicants arguments from Page 4 of Paper No. 12, quoted above, clearly indicate that the liquid filter element was only one of at least two independent claim limitations that each were sufficient to distinguish over the prior art. Since application of the recapture rule to the liquid filter element requires a deliberate intention on the part of Applicants to surrender subject matter associated with the

liquid filter element to overcome prior art, and since Applicants repeatedly and consistently argued that the liquid filter element was not necessary to distinguish over the prior art, there is no basis to apply the recapture rule to Claim 22 (now Claim 15). Moreover, even if the amendment to Claim 22 was necessary to overcome and deliberately made for the purpose of overcoming the prior art, which Applicants dispute, any application of the recapture rule can apply only to Claim 22 (now Claim 15) and its dependents.

The Examiner further states that in the Appeal Brief filed October 29, 1992, Applicants argued "the liquid filter element being a novelty of the patented invention which distinguishes it from the prior art." Initially, Applicants respectfully submit that nowhere in any of the cases discussed above, or even in the Examiner's own statement of the recapture rule, is there support for the Examiner's assertion that a mere argument that a recited element distinguishes an invention over the prior art somehow amounts to a deliberate surrender of the subject matter of that element when, as here, absolutely no narrowing limitations were made to that element for the purpose of overcoming any prior art and it was repeatedly and consistently argued that the recited element was only one of multiple elements that each were sufficient to distinguish over the prior art.

As Applicants stated on Page 4 of the Appeal Brief, "the Houser patent does not show, teach, or suggest (1) an oxygen enriched first combustion chamber, (2) and oxygen starved second combustion chamber, *or* (3) a liquid filter as claimed by Applicants." (emphasis added) Applicants then independently argued on Pages 4-8 the differences between each of these elements and Houser, Hadley, and Kent. In concluding the Appeal Brief, on Page 8, Applicants stated:

The three references cited as prior art do not show, teach, or suggest using air injectors to inject air and waste material into an oxygen rich first combustion chamber, delivering exhaust to an oxygen starved second combustion chamber, *or* using a liquid filter to remove the specified chemicals . . . as expressly claimed by Applicants.

(emphasis added)

Applicants did nothing more than argue the numerous distinctions between their invention and the prior art. Applicants did not in any way narrow the recited liquid filter element to overcome

the prior art. Therefore, the recapture rule is wholly inapplicable in the present situation and the Examiner's rejection should be withdrawn.

Finally, the Examiner asserts that since the Reason for Allowance section of Paper No. 20, mailed December 22, 1992, states "inclusion of 'the liquid filter of chemically treating the exhaust gases to reduce CO, NO and SO gases' which the prior art references fail to show or suggest," and since no remarks from Applicants followed, Applicants are deemed to have agreed with the Examiner and the recapture rule applies. Even if the Examiner is allowed to consider the lack of a response from Applicants to be an admission as to the correctness of the purported reason for allowance, which Applicants vigorously dispute, the Examiner still has provided no basis for application of the recapture rule in this reissue application under the governing law set forth above. The fact remains that absolutely no narrowing limitations were made to the liquid filter element to overcome the prior art, as demonstrated in the above discussion of Paper No. 12, and that Applicants therefore could not have surrendered the subject matter of the liquid filter element under the recapture rule, even as the Examiner has stated the rule.

In view of the governing law and the file history of the original patent, it is evident that Applicants made no deliberate decision in prosecuting the original application to surrender the liquid filter subject matter to overcome prior art, as required for the recapture rule to apply in this reissue application. The reissue claims are broader than the original patent claims in a way that does not attempt to reclaim subject matter, if any, that might possibly have been surrendered with respect to other elements in prosecuting the original application. For all of the reasons discussed above, Applicants respectfully request reconsideration and the allowance of Claims 1-20.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this case in any manner, the Examiner is invited to contact the undersigned Attorney for Applicants at the Examiner's convenience.

Although Applicants believe that no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

Respectfully submitted,

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Date: 9/25/92